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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/816,802	03/23/2001	Konstantinos Psounis	053560-0003	5828
7590	06/22/2004		EXAMINER	
Joseph Yang, Ph.D. Skadden, Arps, Slate, Meagher & Flom LLP 525 University Avenue Palo Alto, CA 94301			WILLETT, STEPHAN F	
			ART UNIT	PAPER NUMBER
			2141	11
DATE MAILED: 06/22/2004				

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	09/816,802	PSOUNIS ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Stephan F Willett	2141	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
  - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
  - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
  - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 20 April 2004.
- 2a) This action is FINAL.                    2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-41 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 1-41 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All    b) Some \* c) None of:
1. Certified copies of the priority documents have been received.
  2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                    | Paper No(s)/Mail Date. _____  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____. | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
|   | 6) <input type="checkbox"/> Other: _____.                                   |

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## DETAILED ACTION

### *Title Change*

1. The title change is satisfactory.

### *Claim Rejections - 35 USC □ 112*

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 1, 23, 32, 36-37 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The “relative” clause that refers to “to said base document” is unclear. The base document is based on abbreviated redundancy, i.e. as described in Chan with “it looks for similar content from a selected set of reference objects, in addition to the object itself”, col. 5, lines 26-28 and the applicant’s specification, thus the base document or object is condensed, as is commonly understood in object oriented programming, and the object is part of a class. Also, it is not clear if the base document is part of the condensed document since only the condensed document is transmitted to “said user”.

4. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

5. Claims 40-41 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. Specifically, “without modifying said browser” in the claims is not enabled in the Applicant’s Specification.

***Claim Rejections - 35 USC § 102***

6. The following is a quotation of the appropriate paragraphs of 35 U. S.C. 102(e) that form the basis for the rejections under this section made in this Office action:

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

7. Claims 1-41 are rejected under 35 U.S.C. 102(e) as being anticipated by Chan et al. with Patent Number 6,178,461.

8. Regarding claim(s) 1, 23, 32, 36-37, Chan teaches a condenser as “encode process 170” between a server and a user as “more compact and efficient form”, col. 4, lines 50-56. Chan teaches a server and a user that accepts user’s document requests, col. 4, lines 22-32. Chan teaches referencing a document with a base document associated with a class as “reference objects”, col. 5, line 2 to obtain said base document as “set of objects”, and “subset”, col. 5, lines 6-8 and/or “from the server cache”, col. 4, lines 33-35. Chan teaches condensing a document as “compressing out the similar parts”, col. 5, lines 29, 24-34 relative to said base document and transmitting the document to a user, col. 4, lines 56-59. Chan teaches a delta coding type process, col. 8, lines 33-34

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9. Regarding claim(s) 2-3, 9, 12, 21, 24, 27, 33, Chan teaches optimizing the sending of a document, for example by size, based on a URL network request, col. 3, lines 64-67.

10. Regarding claim(s) 4, 6, Chan teaches optimizing computational effort as “computational complexity”, col. 1, lines 47-52 and col. 10, lines 55-57, and this indirectly relates to cost, col. 7, lines 60-67.

11. Regarding claim(s) 5, Chan teaches optimizing time of transmission, col. 11, lines 55-57.

12. Regarding claim(s) 7-8, 25, Chan teaches a plurality of classes that meet thresholds, col. 7, lines 1-6.

13. Regarding claim(s) 10, Chan teaches minimizing the differences, col. 5, lines 28-30.

14. Regarding claim(s) 11, 26, 38, Chan teaches creating new classes or objects, col. 4, lines 1-2.

15. Regarding claim(s) 17, Chan teaches replacing the old document with a new document, col. 6, lines 4-8.

16. Regarding claim(s) 18-19, 30, Chan teaches that the base document is anonymous and lack confidential content, col. 8, lines 4-6 and col. 11, line 1 as anonymous URLs and anonymous dictionary entries that will not contain content of a specific user.

17. Regarding claim(s) 13-14, 16, 28-29, 34-35, Chan teaches condensing based on past documents preexisting or cached, col. 5, lines 41-56 wherein documents are cached at the user or proxy for a limited time to be used again and again because they needed often.

18. Regarding claim(s) 15, Chan teaches sending the base document for reconstruction, col. 6, lines 4-8.

19. Regarding claim(s) 20, 22, 31, 39, Chan teaches the request identifies the user and

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document, col. 4, lines 25-27 and determines if a previous request has been made.

20. Regarding claim(s) 21, 33, Chan teaches a document network location as URL, col.4, line 23, and within the same domain, col. 4, lines 41-42 and col. 5, lines 16-19.

21. Regarding claim(s) 40-41, Chan teaches no need to modify a browser by default since it is not mentioned or required in the description, but also since the reference describes a legacy method, among many, to circumvent modifying a completed application, col. 5, lines 11-14.

***Response to Amendment***

22. The broad claim language used is interpreted on its face and based on this interpretation the claims have been rejected.

23. The limited structure claimed, without more functional language, reads on the references provided. Thus, Applicant's arguments can not be held as persuasive regarding patentability.

24. Applicant suggests "additionally ... one or more objects from the user's cache", Paper No. 10, Page 11, lines 1-2. However, as described above in Chan with "from the server cache", col. 4, lines 33-35 such a limited interpretation of the teachings is not reasonable. The applicant does recognize the objects "to be used as reference objects", id., but these do not have to be "stipulated by the user", id., line 4 as argued. The references should not be read in a vacuum, the teachings are not mutually exclusive, and must be taken in context of what was reasonable based on the subject matter as a whole as would have been understood at the time the invention was made to a person having ordinary skill in the art to which the subject matter pertains. The description in the reference is not obfuscated by the numerous other suggested usages of said description in the reference. In an effort to further prosecution, the similarity to objects has been

described and the detailed classes used by objects that are basically condensed documents or code should be recognized, and these aspects of objects are further described in the newer references that were previously cited. Applicant argues “the condenser proxy automatically determines a reference object”, Paper No. 10, Page 11, lines 7-8, but this is the same as “a sever select process”, col. 4, line 34 in Chan. Thus, Applicant’s arguments can not be held as persuasive regarding patentability.

### ***Conclusion***

25. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure is disclosed in the Notice of References Cited. The other references cited teach numerous other ways to perform document condensing, thus a close review of them is suggested, particularly, Schloss et al. with Patent Number 6,249,844, Leighton et al. with Patent Number 6,108,703 and Sokol et al. with Patent Number 6,405,211.

26. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

27. A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this

final action.

28. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Stephan Willett whose telephone number is (703) 308-5230. The examiner can normally be reached Monday through Friday from 8:00 AM to 6:00 PM.
29. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rupal Dharia, can be reached on (703) 305-4003. The fax phone number for the organization where this application or proceeding is assigned is (703) 746-7239.
30. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-9605.

sfw

June 17, 2004



RUPAL DHARIA  
SUPERVISORY PATENT EXAMINER